

### Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claim 11 has been amended to delete "(A)" before the definition of  $R^1$  since all of the other definitions for  $R^1$  beginning with (B) were previously deleted from claim 11.

The definition for  $R^2$  in claim 11 has been amended to delete reference to halogen, the significance of which will be discussed below in connection with the prior art rejection.

Also in the definition for  $R^2$  in claim 11, the word "by" has been inserted before "a  $C_{1-6}$ -alkylenedioxy group", in response to the rejection of this claim under 35 U.S.C. §112 in item 5a on page 4 of the Office Action, which will be discussed below in more detail.

Claim 11 has been further amended to delete the definition for  $R^{10}$ , as no longer being necessary in view of the amended definition of X which has been limited to a -O-CHR<sup>11</sup>- group, referring to the elected Group I subject matter in item 2, and the Examiner's recommendation in item 3 to cancel non-elected subject matter. Also in this regard, the definition for n has been limited to zero.

Also referring to item 3 of the Office Action, the last sentence, the proviso under the definition for Z in claim 11 has been deleted, as no longer being necessary in view of the other amendments to this claim.

Applicants emphasize that the foregoing elections are made while reserving their rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter.

Claim 13 has been amended in view of the amendments to claim 11. Applicants note that the definitions for  $R^3$ ,  $R^4$ ,  $R^9$ , Q, X, W, n and m have been deleted from claim 13 since they are no longer necessary in view of the amendments to claim 11.

Furthermore, referring to item 5b on page 4 of the Office Action, the reference to naphthyl or acenaphthyl has been deleted from the definition of  $R^2$  in claim 13.

Claim 16 has been cancelled in view of the amendment to the definition of X in claim 11.

Claim 17 has been cancelled since n in claim 11 is now limited to zero.

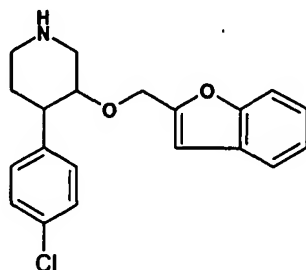
Claim 21 has been amended as recommended by the Examiner in item 6 on page 5 of the Office Action, thus rendering moot the objection to this claim.

The patentability of the presently claimed invention over the disclosure of the reference relied upon the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 11-14 and 19 under 35 U.S.C. §102(b) as being anticipated by Binggeli et al. (WO '311) is respectfully traversed.

The Examiner refers to the compound in this reference corresponding to Applicants' compound where  $R^2$  = phenyl substituted by chloro. However, as indicated above, halogen as a substituent of phenyl in the definition for  $R^2$  has been deleted from claims 11 and 13.

Thus, the Examiner cites the following reference compound (without indicating where exactly the compound is to be found):



A search revealed that a compound "(3RS, 4RS)-3-(Benzofuran-2-ylmethoxy)-4-(chlorophenyl)-piperidin" is disclosed on page 109, 11 of WO '311. This is a racemate, whereas the Examiner refers to the (3R,4R)-diastereomer. Nevertheless WO '311 states on page 8 that pure diastereomers are covered as well. Further, instant formula (I) of the present claim 11 encompasses racemates as well.

Thus, the reference compound on page 109 of the reference does fall under instant Group I compounds, namely a compound of formula (I), where  $R^2$  is phenyl substituted by halogen, and  $R^1$  is unsubstituted benzofuranyl.

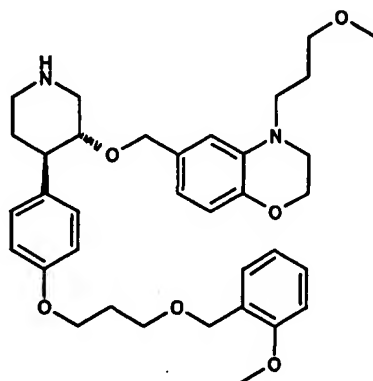
As previously indicated, the reference compound has been excluded from the scope of the present claims by deleting the possibility that  $R^2$  is phenyl substituted by halogen.

For these reasons, Applicants take the position that the rejection of the claims as being anticipated by the Binggeli et al. reference should be withdrawn.

The rejection of claims 11-14 and 19-21 under the second paragraph of 35 U.S.C. §112, as applied to the claims remaining after entry of the foregoing amendments, is respectfully traversed.

With regard to item 5a of this rejection, Applicants respectfully submit that it is very clear from the description and the claims (e.g. see instant claim 13) that the "L1 . . . U radical" is part of the list of possible substituents and not an independent definition of  $R^2$ . This has been clarified by inserting the word "by" before "a  $C_{1-6}$ -alkylenedioxy group" under the definition for  $R^2$  in claim 11. This refers back to the expression "substituted by" after "phenyl" at the beginning of the definition of  $R^2$ , and is consistent with the word "by" (meaning "substituted by") before the "L1 . . . U radical" at the end of the definition of  $R^2$ .

Further in this regard, in the response dated October 20, 2009 to the Office Action of September 19, 2008 constituting a requirement for restriction, the compound of Example 5 was elected:



6-(4-{4-[3-(2-Methoxybenzyloxy)propoxy]phenyl}piperidin-3-yloxymethyl)-4-(3-methoxypropyl)-3,4-dihydro-2H-benzo[1,4]oxazine

The substituent on the phenyl ring was analyzed as follows:

$R^2$  is phenyl, substituted by an L1-T1-L2-T2-L3-T3-L4-T4-L5-T5-U radical, whereby

L1 is absent,

T1 = (g) -O-,

L2 =  $C_3$ -alkylene,

T2 = (g) = -O-,

L3 =  $C_1$ -alkylene,

T3 = (f) =  $-CR^7R^8$  with  $R^7$  and  $R^8$  together with the C-atom to which they bonded are a 6-membered ring,

L4 = absent,

T4 = (g) = -O-,

L5 = absent,

T5 = absent, and

U = C<sub>1</sub>-alkyl.

The Examiner acknowledged this election (and its interpretation), and it thus appears that there is no lack of clarity with regard to the substituents on the phenyl group in the definition of R<sup>2</sup> in claim 11.


The Examiner's position as set forth in item 5b of the rejection under 35 U.S.C. §112 has been rendered moot in view of the amendment to the definition of R<sup>2</sup> in claim 13.

The objection to claim 15 in item 7 is also now moot in view of the amendments to claim 11 on which claim 15 depends.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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